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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,849 03/17/00 NAGATA

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EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/25/01

*10*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/508,849

Applicant(s)

NAGATA ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 9 is/are allowed.
- 6) ☒ Claim(s) 2, 5, 6, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Claims 2-6 and 8-11 are pending.  
Claims 1 and 7 have been canceled.  
Claims 2-6 have been amended.  
Claims 8-11 have been added.  
Claims 2-6 and 8-11 are examined on the merits.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Priority***

3. Acknowledgment is made of Applicant's claim for foreign priority based on an application filed in Japan on September 17, 1997. It is also noted that Applicants assert that a certified copy of the priority document has been forwarded to the USPTO by the International Bureau. The Examiner does not dispute the receipt of the certified document. The Examiner has notified Applicants that to overcome any rejections based on documents between the dates of November 17, 1998 and November 17, 1997 a translation of the foreign should be submitted under 37 CFR 1.55. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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***Withdrawn Objections***

***Specification***

4. The disclosure is no longer objected to because of several misspelled words in the specification. Applicants have amended the specification.

***Claim Objections***

5. Claims 2 and 3 are no longer objected to because Applicants have made clarifying amendments to the claims. However, with the removal of newly added terms “both” and “all of the” this objection will be reinstated.

***Withdrawn Rejections***

***Claim Rejections - 35 U.S.C. § 112***

6. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is withdrawn in light of the cancellation of the claim.

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7. The rejection of claim 7 under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement commensurate with the scope of the claimed invention is withdrawn in light of the cancellation of the claim.

8. The rejection of claims 2-6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn. Claims 1 and 7 have been canceled.

***Claim Rejections - 35 U.S.C. § 102***

9. The rejection of claims 5 and 6 under 35 U.S.C. 102(a) as being anticipated by WO 98/21232 (May 22, 1998/ referenced on IDS) is withdrawn in light of the amendments, however upon removal of new matter this rejection will be reinstated. Claims 1 and 7 have been canceled.

10. The rejection of claims 2, 3 and 5 under 35 U.S.C. 102(b) as being anticipated by Suda et al. (Cell 75:1169-1178, December 17, 1993), as evidenced by Accession 49266 (January 13, 1995) is withdrawn in light of the amendments.

11. The rejection of claim 6 under 35 U.S.C. 102(b) as being anticipated by Suda et al. (Cell 75:1169-1178, December 17, 1993), as evidenced by Accession 49266 (January 13, 1995) is

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withdrawn in light of the amendments, however upon removal of new matter this rejection will be reinstated.

*New Grounds of Rejection*

*Claim Rejections - 35 U.S.C. § 112*

~~12.~~ <sup>drop</sup> Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have amended claim 6 to include text that is not supported by the specification. Claim 6 has been amended to include the recitation “which inhibits Fas-mediated apoptosis.” Applicants have not drawn the Examiner’s attention pointedly to page and line number as to where support for this added recitation can be found in the disclosure.

~~13.~~ <sup>drop</sup> Claims 2, 3, 5, 8, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 2, 3, 10 and 11 are indefinite in the recitation “at least one amino acid residue of from 111th amino acid to 128th amino acid residues”. This recitation is not clear. To

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obviate this rejection Applicants should state "at least one amino acid residue from the 111th amino acid to the 128th amino acid residue"

***Claim Rejections - 35 U.S.C. § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 2 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,183,951 (filed May 12, 1997). Sequence 14 of U.S. Patent #6,183,951 discloses a polypeptide in columns 47 and 48 and the attached database sheet having an amino acid sequence of the natural human Fas ligand wherein the 129th and 130th amino acid residues as measured from the N terminal end are both substituted and at least one amino acid residue from the 111th amino acid to the 128th amino and the 131st amino acid to the 133rd amino acid residues as measured from the N terminal end are substituted. Additionally, Sequences 11 and 13 of the patent displayed in columns 41-47 disclose a DNA coding for the said novel polypeptide (see attached database sheet).

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*Allowable Subject Matter*

16. Claims 4 and 9 are allowed.

*Conclusion*

17. Claims 3, 4, 6-11 are free of the art.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703) 306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. A message may be left on the examiner's voice mail service. If attempts to reach the



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examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Alana M. Harris, Ph.D.  
Patent Examiner, Group 1642  
October 25, 2001

  
SHEELA HUFF  
PRIMARY EXAMINER